

## **REMARKS**

### **I. PRELIMINARY REMARKS**

No claims have been amended, added or canceled. Claims 1-12, 14, 15, 17 and 20-26 remain in the application, of which claims 15, 17, 25 and 26 have been allowed. Reexamination and reconsideration of the application are respectfully requested.

### **II. REJECTIONS UNDER SECTION 112**

#### **A. The Rejections**

Claims 1-11 and 20-22 have been rejected under 35 U.S.C. § 112, first paragraph, as purportedly failing to comply with the written description requirement and the enablement requirement. The rejections under 35 U.S.C. § 112, first paragraph, which are both based on applicant's use of the phrase "at least substantially opaque sheet," are respectfully traversed. Reconsideration thereof is respectfully requested.

#### **B. The Meaning of the Phrase "At Least Substantially Opaque Sheet"**

The first step in an analysis of a claim under 35 U.S.C. § 112, first paragraph, is to determine what, exactly, is being claimed. To that end, and as discussed at length in MPEP § 2111.01, "simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say." *Citations omitted*. Applicant respectfully submits that the phrase "at least substantially opaque" is a collection of simple English words that would be understood by one of ordinary skill in the art as describing a sheet that is, at a minimum, close enough to being impenetrable to light to prevent indicia on one side of the sheet from being viewed from the other side of the sheet.

Starting with the word “opaque,” the plain meaning this word is “impenetrable by light; neither transparent nor translucent.” *The American Heritage® Dictionary of the English Language* (4<sup>th</sup> Ed. 2000).

Turning to the word “substantially,” this word is commonly used in patent claims to describe situations where there may be some degree of variation. See *Andrew Corp. v. Gabriel Electronics Inc.*, 6 USPQ2d 2010, 2012 (Fed. Cir. 1988). Thus, something that is “substantially opaque” is either completely impenetrable to light, or is somewhat close. The Examiner’s attention is also directed to U.S. Patent No. 6,455,119 to Carides et al. (“the Carides patent”). The Carides patent, which is classified in class 428/040.1 (i.e. the same class and subclass as the present application), includes the following description of the structure illustrated in Figure 2 thereof:

If completely or **substantially opaque**, game portion 22 may include text, symbols, or other information on its underside 70 that is **obscured from view** on the one hand by its upper surface 74 and on the other by the base ply 14. Similarly, because game portion 22 obscures central area 38 of upper surface 58 from view, hidden textual or other information may be printed or otherwise included thereon as well.

[Column 5, lines 31-35, emphasis added.] In other words, the Carides patent indicates that indicia on one side of the substantially opaque game portion 22 cannot be viewed from the other side of the substantially opaque game portion 22.

Finally, the phrase “at least” is a common English phrase that means “not less than.” *The American Heritage® Dictionary of the English Language* (4<sup>th</sup> Ed. 2000). There is also no end to the use of this phrase in the patent arena. 35 U.S.C. § 111(a), for example, mandates that a complete non-provisional patent application include “at least one claim.” Thus, there cannot be less than one claim in an application, i.e. there must be one claim at a minimum, but there can be more than one claim. Applicant’s use of the phrase is no different. The phrase “at least” is simply being used to set a minimum level.

In view of the forgoing, applicant respectfully submits that one of ordinary skill in the art would understand that an “at least substantially opaque sheet” is a sheet that is, at a minimum, close enough to being impenetrable to light to prevent indicia on one side of the sheet from being viewed from the other side of the sheet. The 35 U.S.C. § 112, first paragraph, support in the application as filed for such a sheet is discussed below.

***Finally, to the extent the Examiner has taken the position that the phrase “at least substantially opaque sheet” means something other than the definition discussed above, applicant hereby requests the next Action from the Examiner (1) clearly say so, (2) precisely indicate what definition is being employed and (3) provide a basis for the alternate definition, in order to clarify the issues for appeal.***

### **C. The Written Description Rejection**

Although the specification does not include the exact phrase “at least substantially opaque sheet,” applicant notes that the “claimed subject matter need not be described *in haec verba* in the specification in order for that specification to satisfy the description requirement.” *In re Smith and Hubin*, 178 USPQ 620, 624 (CCPA 1973). Rather, applicant need only convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the claimed invention. “One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Lockwood v. American Airlines, Inc.*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See also MPEP § 2163.02.

The present application disclose a variety of exemplary sheets that one of skill in the art would recognize as being “at least substantially opaque,” i.e. a sheet that is, at a minimum, close enough to being impenetrable to light to prevent indicia on one side from being viewed from the other side. In particular, on page 5, lines 19-23, the specification identifies “photo-grade and other heavy weight paper” and “card stock” as suitable sheet materials. At least substantial opacity is an inherent characteristic of “photo-grade and other heavy weight paper” and “card stock.” Thus, a variety of “at least substantially opaque sheets” are described in accordance with MPEP § 2163.07(a). The above-referenced portion of the specification also refers to “foil,” which is commonly at least substantially opaque, thereby providing additional written description support.

In view of the forgoing, applicant respectfully submits that the written description rejection under the first paragraph of 35 U.S.C. § 112 is improper and should be withdrawn.

#### **D. The Enablement Rejection**

At the outset, applicant notes that the stated basis for the enablement rejection is as follows:

The phrase “substantially opaque” is found to be lacking enablement because it is unclear as to what is defined by “substantially.” It is also not clear as what is considered meant by “substantially” opaque?

[Office Action at page 2.] There are at least two errors associated with this statement. First and foremost, one of ordinary skill in the art would, as discussed above, understand what an “at least substantially opaque sheet” is. Second, a purported lack of clarity in claim language is not a proper basis for an enablement rejection under the first paragraph of 35 U.S.C. § 112. The actual standard for enablement is, quite simply, whether or not the application, as filed, includes enough information to enable one of ordinary skill in the art to **make and/or use** the claimed invention. See MPEP § 2164.01. The present specification meets this standard.

Notwithstanding the fact that one of ordinary skill in the art would be able to obtain a substantially opaque sheet with no help whatsoever from the present specification, the present specification identifies a plurality of sheet materials that are at least substantially opaque. More specifically, on page 5, lines 19-23, the specification identifies “photo-grade and other heavy weight paper” and “card stock,” which are “at least substantially opaque,” as suitable sheet materials. This portion of the present specification also refers to “foil,” which is commonly at least substantially opaque. As such, armed with the teachings of the specification, one of ordinary skill in the art would be able to make and/or use this aspect of the claimed invention. The enablement rejection under the first paragraph of 35 U.S.C. § 112 is, therefore, improper and should be withdrawn.

### III. PRIOR ART REJECTIONS

#### A. The Rejections

Claims 14 and 23 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 3,950,580 to Boudet (“the Boudet patent”). Claim 24 has been rejected under 35 U.S.C. § 103 as being unpatentable over the Boudet patent. The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

#### B. The Cited Reference

The Boudet patent is directed to device for displaying address labels on a letter or parcel. The device includes a transparent sheet 1, through which an address label may be viewed, and adhesive 2 along the edges of the transparent sheet. The adhesive 2 along three of the edges is covered by film strips (not shown), while the adhesive material along **one of the edges** is divided into a pair of adhesive strips and is covered by a pair of film strips 4 and 5. Because the adhesive along one of the edges is divided into a pair of adhesive strips and covered by a pair of film strips, the device may be used twice, as is discussed in column 1, lines 47-68.

#### C. Discussion

Independent claim 14 calls for a combination of elements including, *inter alia*, “a sheet defining ... first and second intersecting side edges ... one of longitudinal ends of each of the first and second side edges defining a common longitudinal end,” “**a plurality of first strips of adhesive** material ... adjacent to the **first side edge**,” “**a plurality of second strips of adhesive** material ... adjacent to the **second side edge**,” “**a plurality of first liners** respectively positioned over the plurality of **first strips** of adhesive material” and “**a plurality of second liners** respectively positioned over the

plurality of **second strips** of adhesive material.” The respective combinations defined by claims 23 and 24 include, *inter alia*, the elements recited in claim 14.

With respect to the rejection under 35 U.S.C. § 102, the Boudet patent fails to teach or suggest each and every element of the combination recited in independent claim 14. For example, and as noted in the amendment filed on January 6, 2006, **only one side edge** of the Boudet device has a **plurality** of adhesive strips **and** a corresponding **plurality** of liners. The combination defined by claim 14, on the other hand, calls for **two side edges** to have a **plurality** of adhesive strips and a plurality of liners.

In response to arguments similar to those above, the Office Action states that “as shown in the drawing of Boudet, the first adhesive strip is along a first side of the sheet and the second adhesive strip is located along the second side of the strip [sic].” [Office Action at page 3.] In other words, the Office Action failed to even assert that the Boudet patent includes all of the elements recited in independent claim 14.

The rejection of claims 14 and 23 under 35 U.S.C. § 102 is, therefore, improper and should be withdrawn.

Additionally, in order to clarify the issues for appeal, applicant hereby requests that the next Action from the Examiner include a copy of Boudet drawing with text and lead lines clearly identifying (1) the **plurality of first strips** of adhesive material ... adjacent to the **first side edge**, (2) the **plurality of first liners** respectively positioned over the plurality of first strips of adhesive material, (3) the **plurality of second strips** of adhesive material ... adjacent to the **second side edge**, and (4) the **plurality of second liners** respectively positioned over the plurality of second strips of adhesive material.

Turning to the rejection under 35 U.S.C. § 103, applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the Boudet device such that more than one of the sheet sides included a plurality of adhesive strips and a corresponding plurality of liners. The Boudet “send and re-send” process discussed in column 1, lines 47-68 **only requires one side** of sheet 1 to include a plurality of adhesive strips and a corresponding plurality of liners. Claim 24 is, therefore,

patentable for at least the same reasons as independent claim 14 and the rejection of claim 24 under 35 U.S.C. § 103 should also be withdrawn.

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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